

REMARKS

A. INTRODUCTION

This paper is responsive to the Non-final Office Action mailed on February 7, 2008 (hereinafter the “Office Action”). The previous Office Action, which was the Final Office Action mailed on November 14, 2006, is referred to below as the “Final Action”.

Claims 1-3, 5-13, 15-21, 23-27 and 29-43 are pending and rejected. Of these, claims 1, 8, 9, 10, 17, 18, 19, 26, 32, 33, 34, and 35 are the only independent claims (12 independent claims).

B. SECTION 112, FIRST PARAGRAPH REJECTIONS

Claims 35-43 were rejected under Section 112, first paragraph as failing to comply with the written description requirement. We traverse.

As explicitly directed in the MPEP: “In rejecting a claim, the examiner must set forth express findings of fact which support the lack of written description conclusion...These findings should:

- (A) Identify the claim limitation(s) at issue; and
- (B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.” MPEP 2163.04(I).

In addition, during examination, claims are given their broadest reasonable interpretation that those skilled in the art would reach, consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2D 1664, 1667 (Fed. Cir. 2000); *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2D 1464, 1468 (Fed. Cir. 1999). The “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in

applicant's specification." *In re Morris*, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2D 1023, 1027 (Fed. Cir. 1997).

With regard to a Section 112, first paragraph rejection, the Examiner has the initial burden of presenting evidence or reasoning to explain, by a preponderance of the evidence, why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. See *In re Wertheim*, 541 F.2d at 263, 191 USPQ at 97 (CCPA 1976). "The description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description." MPEP 2163 (III) (A).

The proper inquiry for the written description requirement of Section 112, first paragraph, is whether the specification describes the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116; MPEP 2163(I). "An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997)." MPEP 2163(I)

"The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed." See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117. MPEP 2163(I)(B)

For the reasons set forth in detail below, Applicants respectfully submit that a *prima facie* case of unpatentability has not been made for claims 35-43 based on this Section 112, first paragraph rejection because these claims do comply with the written description requirement. Moreover, the Section 112 rejection does not provide even the minimal threshold of clarity required by 35 U.S.C. §132. Accordingly, the rejections of claims 35-43 under Section 112, first paragraph should be withdrawn.

It is respectfully asserted that the present application provides clear support for the claim language of claims 35-43, including for the terms identified by the Examiner of “maximum value”, “displaying” and “associating prizes”. In particular, the application at page 15, line 22 to page 20, line 5, with reference to Figs. 4 and 5, discloses a third embodiment of a scratch-off lottery game ticket for a “Twenty-One” type game. With regard to the term “predetermined maximum value” as recited by dependent claims 36-39, it is common knowledge that the maximum value for a “blackjack” playing card-type game is twenty-one (and further that the other commonly known name for such a game is “21”). In addition, the rules printed on the face of the lottery tickets state that the player cannot go over “21” during play when attempting to beat the dealer total shown on the ticket (see reference numbers 310 and 302 of Figs. 4 and 5). It is therefore clear that the value “21” is the predetermined maximum value. Accordingly, we respectfully assert that at least the example “Twenty-One” lottery game described in the current application provides adequate support for the term “predetermined maximum value”, and therefore that the specification describes the claimed invention in sufficient detail so that one skilled in the art would reasonably conclude that the inventor had possession of the claimed invention.

Similarly, there is adequate support for “displaying” a plurality of game elements and/or for “displaying” a total game element, as recited by independent claim 35. For example, Figs. 4 and 5 and accompanying text at page 15, lines 23-28 and page 16, lines 19-30 provide support for displaying game elements. Furthermore, the passage on page 19, lines 20-23 includes a list of devices, any of which could be used for displaying a lottery card 300. Likewise, there is adequate support for the term “associating prizes” with a first continuous path and/or with a second continuous path, as recited by claim 35. For example, the specification on page 18, lines 17-19 describes associating a monetary and/or non-monetary prize with a card 300, which corresponds to the “Twenty-One” lottery game ticket.

In view of the above remarks, Applicants respectfully submit that the specification describes the claimed invention in sufficient detail so that one skilled in the art can reasonably conclude that the inventors indeed had possession of the claimed invention. Accordingly, the Examiner has failed to establish a *prima facie* case of lack of written description for any of claims 34-43.

Furthermore, we respectfully submit that the Examiner has not identified a claim limitation that allegedly is not adequately supported by the specification as filed, much less provided adequate reasoning as to *why* the specification as filed would not convey with reasonable clarity that Applicants were in possession of the invention as claimed as of the filing date of the application, which is the proper inquiry to be satisfied. In fact, as is clear from the remarks above and from the pending application, each limitation of claims 35-43 is clearly supported by the specification as filed.

In view of the above remarks, the Applicants request withdrawal of the Section 112, paragraph 1 rejection of claims 35-43.

C. SECTION 102(E) / 103(A) REJECTIONS

Claims 1-3, 5-11, 13, 15-21, 23-27, and 29-43 were rejected under Section 102(e) or in the alternative under Section 103(a), for allegedly being obvious over Riendeau et al., U.S. Patent No. 6,761,633 (hereinafter “Riendeau”) in view of Smith, U.S. Patent No. 5,411,260 (hereinafter “Smith”).

Claim 12 was rejected under Section 103(a) in light of Riendeau and Sultan (U.S. Patent No. 6,273,817), as set forth in the Final Action.

1. The Riendeau and Smith Patents

Riendeau discloses an online game of chance with multiple paths on a virtual scratch ticket, wherein the game is arranged in the form of a map with a plurality of branches and nodes corresponding to paths. Game play begins at a starting point, and the player then clicks on a branch or a node corresponding to a desired path. Each selection results in either a prize increment, a prize decrement, or an award of a bypass token. The object of the game is to maximize the final score by maximizing prize increments while minimizing prize decrements. When a finishing point is reached, a final prize is awarded to the one or more players (see Riendeau, col. 2, lines 7-23).

Smith discloses a game resembling a maze that includes two grids, a first grid 14 that defines multiple boxes 18, and a second grid 30. The first grid may be denominated a “travel

card", and dictates how the player "travels" when playing the game. That is, the first grid contains instructions that the player must follow when the player selects the boxes of the second grid (see Smith, col. 2, line 58 to col. 3, line 21). The game embodiment shown in Fig. 4 requires the player to initially scratch-off the coating 46 from the first grid 14 to expose symbol sets 22 within the boxes 18. For each symbol set 22, the player determines whether there is a match with any of the symbols 42B or 42C included in boxes 62 of the grid 58, and if so the player removes the opaque coating 46 from the box(es) containing matching symbols. The player continues in this manner until the symbol set 22 is exhausted, and then ascertains if any first symbols 42A were revealed. If a sufficient number have been exposed to form a continuous path between any two boundaries of the grid, then the player is entitled to a prize (Col. 4, lines 15-37).

2. Independent Claims 1, 8, 9, 10, 17, 18, 19, 26, 32, 34 and 35

2.01. Method Claims 1, 10, 19, 26, 34 and 35 are *not* product-by-process claims

The Examiner contends that his position concerning independent method claims 1, 10, 19, 26, 32, 34 and 35 as being product-by-process claims is supported by the Pre-Appeals Board conference of February 13, 2007 (See Office Action, page 4). But the Applicants have not been made aware of the particulars of that conference, and thus cannot address that of which we have no knowledge. Accordingly, Applicants respectfully request disclosure of those points and/or items that support the Examiner's position concerning this issue in the next Office communication regarding the present application so that such points can be addressed.

We understand that the Examiner continues to explicitly reject these claims based on that determination. But a product-by-process claim is a claim *to a product itself* (e.g., to an apparatus, device, manufacture or composition of matter), and *defines the claimed product in terms of the process* by which it is made. Emphasis added, see MPEP §2173.05(p)(I). Claims 1, 10, 19, 26, 34 and 35 each claim methods (as the Examiner admits of claim 1 at page 2 of the Final Action) and are *not* claims to products (much less product-by-process claims).

2.02. The Examiner explicitly bases the Section 102(e)/Section 103(a) rejections of Claims 1, 10, 19, 26, 34 and 35 on the finding that they are product-by-process claims

The Examiner states (See page 3 of the Office Action, emphasis added):

“With respect to claims 1, 10, 34 and 35; ... and claims 19 and 26 respectively drawn to ‘a method of production a scratch-off lottery ticket’... ‘a method for facilitating game play’ the rules of play are not considered to distinguish over the applied art as being drawn to product by process claims.”

Thus, we submit that the Section 102(a)/Section 103(a) rejections of independent claims 1, 10, 17, 18, 19, 26, 34 and 35 (and dependent claims 2-3, 5-7, 11-13, 15, 16, 20, 21, 23-25 and 36-43) are still based on the erroneous determination that the independent method claims are product-by-process claims, and the subsequently erroneous conclusion that limitations concerning the “rules of play” do not distinguish over Riendeau, ostensibly because such limitations do not imply “structure.”

2.03. No *prima facie* case of obviousness has been established due to the improper construction of method claims 1, 10, 17, 18, 19, 26, 34 and 35 as product-by-process claims

Applicants respectfully reassert that the Examiner has fundamentally misconstrued independent claims 1, 10, 17, 18, 19, 26, 34 and 35 as being product-by-process claims. As a result, particular limitations of these method claims have been ignored because they allegedly do not imply structure to a product. Furthermore, the determination of patentability must be based on the recited process steps, not on an end-product the Examiner believes may be produced by the steps. Accordingly, the Examiner cannot have established a *prima facie* case of obviousness for any of claims 1-3, 5-13, 15, 16, 19-21, 23-27, 29-31, and 34-43.

Furthermore, Riendeau does not teach or suggest all of the features of claims 1, 8, 9, 10, 17, 18, 19, 26, 32, 33, 34 and 35.

Independent claim 1 includes a feature of:

- *wherein in accordance with a game rule associated with the lottery ticket any one of the plurality of play symbols printed in the play area of the lottery ticket is selectable as an initial player selection*

Claims 8 and 9 incorporate by reference the above limitation of claim 1.

Independent claim 10 includes a feature of:

- *wherein in accordance with a game rule associated with the ticket any one of the plurality of nodes printed in a pattern spanning the play area of the ticket is selectable as an initial player selection*

Claims 17 and 18 incorporate by reference the above limitation of claim 10.

Independent claim 19 includes a feature of:

- *wherein any one of the nodes [in the play area] is selectable at the start of a game of the simulated scratch-off lottery ticket*

Claims 20, 21 and 23-25 incorporate by reference the above limitation of claim 19.

Independent claim 26 includes a feature of:

- *wherein any one of the nodes [spanning the play area] is selectable at the start of a game of the simulated scratch-off lottery ticket*

Claims 27 and 29-31 incorporate by reference the above limitation of claim 26.

Independent claim 34 includes the feature of:

- *establishing a rule of a game in which any one of a plurality of printed play symbols spanning a play areas of a lottery ticket is selectable as an initial player selection in the game;*

We respectfully assert that Smith also fails to teach or suggest any of the features highlighted above. But the Examiner contends:

“Alternatively, Smith teaches that a player may select any symbol as long as it forms a continuous path from one boarder to another.” (see page 3 of the Office Action)

The above statement is incorrect. Not only was no citation to Smith for such a statement provided, we respectfully assert that no portion of this reference supports the Examiner's statement because Smith actually teaches the opposite. In fact, Smith pertains to a maze-type game having a first grid that dictates how the player "travels" when playing to uncover boxes of a second grid (see Smith, col. 3, lines 1-5). Accordingly, Applicants respectfully submit that the disclosure of Smith has been misconstrued, as this reference actually teaches away from permitting a player to select any play symbol printed in the play area of a lottery ticket as claimed. In contrast to that required by the pending claims, Smith teaches a game wherein a player only removes opaque coatings of the second grid that match any of the symbols of a first grid (see col. 4, lines 15-25).

We respectfully reassert that Riendeau does not teach that any one of the plurality of play symbols or nodes in the play area of a ticket is selectable by a player as an initial player selection. But the Examiner believes that:

"Inherently, in Riendeau 'any one of the plurality of play symbols ... is selectable' meeting the limitations of the claims." (See Final Action, page 3)

We disagree. Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing descriptive material is necessarily present, not merely probably or possibly present, in the prior art. Emphasis added, see *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002). Thus, the question raised by the Examiner is whether one skilled in the art would read any portion of Riendeau as necessarily, not probably or possibly, showing a process (or processes) that included every feature of claims 1, 10, 17, 18, 19, 26, 34 and 35. But it has not yet explained to the Applicants how Riendeau "inherently" (i.e., necessarily) teaches what the Examiner asserts.

To the contrary, Riendeau specifically teaches that a player must make a first selection at the start of the game from one of the designated "nodes". Thus, a player cannot just select any one of the depicted "nodes" or points in the play area at the start of the game. For example, a

player could not first select a “finishing point” in Riendeau or select some other mid-point in the displayed branches.¹

Furthermore, we respectfully reassert and incorporate by reference in their entirety, our arguments presented in the Request for Continued Examination regarding claims 19 and 26 with regard to Riendeau, which will not be repeated herein for the sake of brevity. In particular, we again respectfully assert that the spaces “01” and “16” of Riendeau are *individual points* that by themselves cannot span the indicated play area nor form paths. In particular, single points cannot form paths.

Accordingly, in view of the above remarks, Applicants respectfully assert that the Examiner has not established with substantial evidence that all of the features of independent claims 1, 8-10, 17, 18, 19, 26, 32, 33, 34 or 35 were known or desirable. Accordingly, a *prima facie* case of obviousness has not been established for claims 1 (and its dependent Claims 2, 3, and 5-7), 8, 9, 10 (and its dependent Claims 11-13, 15, and 16), 17, 18, 19 (and its dependent claims 20, 21 and 23-25), 26 (and its dependent claims 27 and 29-31), 32, 33, 34 and 35 (and its dependent claims 36-43).

Thus, in view of the above remarks, Applicants respectfully request withdrawal of all of the Section 102(e) and/or the Section 103(a) rejections of claims 1-3, 5-11, 13, 15-21, 23-27 and 29-43.

2.04. Claims 2 and 11

Claims 2 and 11 require printing of symbols in such a manner as to provide for potentially continuous paths to be non-continuous paths and to provide for printed symbols that indicate discontinuities in paths, respectively. Applicants respectfully assert that Riendeau does not suggest any such functionality or such printed symbols, and neither does Smith.

The Examiner now contends that the “negative symbols” of Riendeau can be considered to be “void” symbols that are “capable” of being used to cause paths to be non-

¹ See, e.g., Abstract (“as play progresses between a starting point and multiple finishing points”); See also, FIG. 1, FIGS. 2A-2B (“START” 52); Column 7, lines 1-4 (“According to a sample game, the player’s current position is marked using a marker (herein depicted as a star) at a starting point 52 (see FIG. 2A). From there the player must choose between a first branch 62 and a second branch 64.”) (emphasis added).

continuous “as set forth in the previous grounds for rejection”. It has also now been alleged that the term “void symbol” has not been recited with any further structure other than to the rules of play, and thus the term “void symbol” is interpreted as indicia indicating a “wrong choice”. (See Office Action, pages 3 to 4). First, there is absolutely no suggestion that the “negative symbols” of Riendeau cause paths to be non-continuous or indicate discontinuity. To the contrary, it is clear that a player of the Riendeau game continues along a path *even if the revealed number is negative* (i.e., a prize decrement). Second, claim 2 requires that the void causes “at least one potentially continuous path that includes the void symbol to be a non-continuous path”, and claim 11 similarly recites that the at least one symbol “is a symbol that indicates a discontinuity in at least one of the paths.” Thus, each of claims 2 and 11 claims, with particularity, a void symbol that indicates a discontinuity for the scratch-off game. Riendeau does not teach or suggest such a symbol, and therefore fails to anticipate or render obvious that which is claimed by pending claims 2 and 11.

We note that Smith was cited in the alternative to address the limitations of claims 2 and 11 (See Office Action, page 2). However, as explained in detail above, Smith does not cure the deficiencies of Riendeau. Although Smith does teach “wrong way” symbols, in contrast to that required by the pending claims, Smith teaches a game wherein a player only removes opaque coatings of the second grid that match any of the symbols of a first grid (see Smith, col. 4, lines 15-25). Thus, Smith specifically teaches a maze-type game having a first grid that dictates how the player “travels” when playing to uncover boxes of a second grid (see col. 3, lines 1-5), which teaches away from permitting a player to select any play symbol printed in the play area of a lottery ticket as claimed by independent claim 1. Thus, claim 1 is patentably distinct thereover, and dependent claims 2 and 11 should also be allowable for at least the same reasons.

In view of the above remarks, Applicants respectfully request withdrawal of the Section 102(e) and/or Section 103(a) rejection of claims 2 and 11.

3. Claim 12

Claim 12 was rejected under Section 103(a) as allegedly being unpatentable over Riendeau in view of Sultan, U.S. Patent No. 6,273,817 (hereinafter “Sultan”).

We note that the particulars for this rejection are contained in the Office Action mailed on September 29, 2005, which contains the admission that “Riendeau shows indicia but fails to show the use of bar code indicia” (See Action mailed September 29, 2005 at page 2). However, the rejection also includes a statement that it would have been obvious to replace the indicia of Riendeau to make it machine readable as taught by Sultan. But Sultan does not cure the deficiencies of Riendeau discussed above with regard to claim 1, specifically it does not teach or suggest the limitation of: *in accordance with a game rule associated with the lottery ticket any one of the plurality of play symbols printed in the play area of the lottery ticket is selectable as an initial player selection*. Accordingly, claim 1 is patentably distinct thereover, and dependent claim 12 should be allowable for at least the same reasons.

In view of the above remarks, we respectfully request withdrawal of the Section 103(a) rejection of claim 12.

D. ADDITIONAL COMMENTS

Our silence with respect to the Examiner’s other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, the Examiner’s interpretation of claimed subject matter or the Specification, or the propriety of any asserted combination(s) of teachings, is not to be understood as agreement with the Examiner. As the Examiner has not established an unrebuttable *prima facie* case for rejecting any of the pending claims, for at least the reasons stated in this paper, we need not address all of the Examiner’s assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.

E. AUTHORIZATION TO CHARGE APPROPRIATE FEES

Applicants hereby submit an Information Disclosure Statement, and have authorized the required fee to be charged to our Deposit Account. As the present Response is being filed within three months of the Office Action, we do not believe that any other fees are due, but if a fee should be necessary to continue prosecution of the present application, please charge any such required fee to our Deposit Account No. 50-0271. In addition, please credit any overpayment to Deposit Account No. 50-0271.

F. CONCLUSION

It is respectfully submitted that all of the claims are in condition for allowance. Thus, the Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Stephan Filipek at telephone number (203) 461-7252 or via electronic mail at sfilipek@walkerdigital.com.

Respectfully submitted,

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